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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/876,276	06/16/1997	JAY SHORT	09010/020001	4852

28213 7590 05/07/2002

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EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 05/07/2002

28

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

08/876,276

Applicant(s)

SHORT ET AL.

Examiner

David J. Steadman

Art Unit

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-- The MAILING DATE of this communicati n appears on the c ver sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_ .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 27 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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## **DETAILED ACTION**

### ***Application Status***

Claims 19-45 are pending in the application.

Amendment to claim 21 in Paper No. 21, filed 02/12/02 is acknowledged.

Receipt of an Information Disclosure Statement in Paper No. 27, filed 04/17/02 is acknowledged.

Applicants' arguments filed in Paper No. 21 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

The text of those sections of Title 35 U.S. Code not included in the instant action can be found in a prior Office action.

### ***Specification/Informalities***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "High Throughput Fluorescence-Based Screening for Novel Enzymes". See MPEP § 606.01.

### ***Claim Objections***

2. Claim 30 is objected to because of the recitation of "C12FDG". Abbreviations, unless otherwise obvious and/or commonly used in the art, should not be recited in the claims without at least once reciting the entire phrase, i.e., "C12-flourescein-di-beta-D-galactopyranoside" for which the abbreviation is used.

### ***Claim Rejections - 35 USC § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 19-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 19 (claims 20-45 dependent therefrom) is confusing in the recitation of "library containing a plurality of clones". It is unclear as to how a library contains clones. It is suggested that the term "library containing a plurality of clones" be replaced with, for example, "library of clones".
5. Claim 20 (claim 20 dependent therefrom) is unclear in the recitation of "further comprising... ..an enzymatic activity of interest". It is unclear as to whether the step of "further comprising... ..an enzymatic activity of interest"
6. Claim 39 is unclear in the recitation of the term "biopanning". It is unclear from the claims and the specification as to the meaning of the term "biopanning". It is suggested that applicants clarify the meaning of the term.
7. Claim 42 is confusing in the recitation of "clone contains DNA obtained from a single organism". It is unclear as to how a clone can contain <sup>DNA</sup> ~~from~~ <sub>215</sub> more than one organism as recited in claim 19 and also contain DNA from a single organism. It is suggested that applicants clarify the meaning of the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 19-21, 35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Abeijon et al. (Proc Natl Acad Sci USA 93:5963-5968, 1993). Claims 19-21, 35, and 37 are drawn to a method for identifying a bioactivity or biomolecule of interest. Abeijon teaches a method of isolating a polynucleotide encoding uridine diphosphate-N-acetylglucosamine (UDP-GlcNAc) transporter from *Kluyveromyces lactis* Golgi apparatus. Abeijon teaches transformation of a *K. lactis* mutant, mmn2-2, with a genomic library

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from wild-type *K. lactis* inserted in the pKD1-derived vector KEp 6 (page 5963, abstract and page 5964, top left). Abeijon teaches vector KEp 6 comprises DNA from other organisms including *Escherichia coli* vector sequence (page 5964, top left). Abeijon teaches transformants expressing UDP-GlcNAc transporter were isolated by monitoring cell surface labeling with fluorescein isothiocyanate conjugated to *Griffonia simplicifolia* lectin, which binds terminal N-acetylglucosamine, using a fluorescence activated cell sorter, or FACS (page 5963, abstract). This anticipates claims 19-21, 35, and 37 as written.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 19-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-11, 15, 16, 18, 19, and 21-23 of U.S. Patent No. 6,174,673. The rejection was fully explained in a previous Office action (see Paper No. 23). Applicants request delay of response to this rejection until the claims of the instant application are found to be in

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condition for allowance. Applicants' argument has been fully considered and is not found persuasive to overcome the rejection. The rejection is maintained for the reasons of record.

***Conclusion***

11. No claim is condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:30 am to 2:00 pm and from 3:30 pm to 5:30 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.

  
PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER